



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/091,276	03/05/2002	David Brian Wecker	MSFT-0765/190453.1	5624
41505	7590	05/19/2006	EXAMINER	
WOODCOCK WASHBURN LLP (MICROSOFT CORPORATION)			STORK, KYLE R	
ONE LIBERTY PLACE - 46TH FLOOR			ART UNIT	
PHILADELPHIA, PA 19103			PAPER NUMBER	
			2178	

DATE MAILED: 05/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/091,276

Applicant(s)

WECKER ET AL.

Examiner

Kyle R. Stork

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This final office action is in response to the remarks filed 6 March 2006.
2. Claims 1-25 are pending. Claims 1, 16, 21, and 24 are independent claims.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title; if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-14, 16-20, 24, 25 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Austin (US 6701315, filed 20 June 2000) and further in view of Stefik (US 5715403, filed 23 November 1994) and further in view of Martin (US 5618232, patented 8 April 1997).

In regard to independent claim 1, Austin discloses retrieving a first instance of archived material comprising a plurality of items, the plurality of items comprising at least one requested item comprising text and at least one image and at least one accompanying, non-requested item; and determining that the at least one accompanying, non-requested item of the plurality of items is substitutable (Austin Col 6 Lines 1-5 and Col 11 Lines 40-45 i.e. text and images; Austin Col 17 Lines 25-30 i.e. non-requested item; Austin Col 10 Lines 1-32); selecting a new item according to at least one rule (Austin Col 11 Lines 19-25 and Col 12 Lines 13-25).

Austin does not specifically disclose generating a second instance of archived material by replacing the at least one substitutable item in the first instance with the new item. However Stefik mention replacing or substituting information (Stefik Col 20 Lines 58-67 and Col 21 Lines1-3). It would have been obvious to one of ordinary skill in the art to apply Stefik to Austin providing Austin the benefit of substituting or replacing information, which would be easier for the user.

Austin further fails to disclose use of a rule comprising selection based upon a geographical location associated with a user. However, Martin discloses use of a rule comprising selection based upon a geographical location associated with a user (column 5, lines 12-44: Here, a rule specifies what data is available to a user based upon the geographic location of the user). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Austin and Stefik with Martin, since it would have allowed a user to restrict content to legal and appropriate content (Martin: column 5, lines 37-44).

In regard to dependent claim 2, Austin does not specifically disclose further comprising charging a fee to a provider of the new item for replacing the at least one substitutable item with the new item. However Stefik discloses of a fee being charged (Stefik Col 4 Lines 34-40). It would have been obvious to one of ordinary skill in the art to apply Stefik to Austin providing Austin the benefit of charging a fee to make a profit.

In regard to dependent claim 3, Austin discloses further comprising rendering the second instance of archived material. (Austin Col 9 Lines 29-35)

In regard to dependent claim 4, Austin discloses wherein the first instance is retrieved from a data store resident on a first computing device, and wherein the method further comprises transmitting the second instance to a second computing device communicatively coupled to the first computing device. (Austin Col 6 Lines 20-39)

In regard to dependent claim 5, Austin discloses wherein the substitutable item comprises a substitutable advertisement and the new item comprises a current advertisement. (Austin Col 10 Lines 33-45)

In regard to dependent claim 6, Austin does not specifically disclose wherein the substitutable item has a first position on a page and a first size, the new item has a second position on the page and a second size and the first size is substantially identical to the second size and the first position is substantially identical to the second position. However Stefik mentions different sizes of item, which could be substituted (Stefik Col 34 Lines 45-55). It would have been obvious to one of ordinary skill in the art to apply Stefik to Austin providing Austin the benefit of substituting items with similar sizes to ensure correct formatting.

In regard to dependent claim 7, Austin discloses wherein at least a particular one of the plurality of items is described by meta-data. (Austin Col 9 Lines 54-60)

In regard to dependent claim 8, Austin does not specifically disclose wherein the meta-data comprises geometric data, which specifies the position of the item on a page. However Stefik mentions a location of an item (Stefik Col 34 Lines 45-55). It would have

Art Unit: 2178

been obvious to one of ordinary skill in the art to apply Stefik to Austin providing Austin the benefit of identifying the location on the page so the user can find the information.

In regard to dependent claim 9, Austin discloses wherein the meta-data comprises category data that specifies that the particular one of the items is either text, collateral content, or an image. (Austin Col 6 Lines 1-5)

In regard to dependent claim 10, Austin does not specifically disclose wherein the meta-data comprises temporal relevancy data, which represents a date beyond which the item is substitutable. However Stefik mentions specific dates used (Stefik Col 11 Lines 1-24). It would have been obvious to one of ordinary skill in the art to apply Stefik to Austin providing Austin the benefit of determining a correct date so as to substitute correct items.

In regard to dependent claim 11, Austin discloses wherein the meta-data comprises a link to information related to the item. (Austin Col 6 Lines 3-10)

In regard to dependent claim 12, Austin discloses wherein the related information comprises at least one of: a document, a text item, an image item, a collateral content item, and a coupon. (Austin Col 9 Lines 54-60) (Austin Col 6 Lines 1-5)

In regard to dependent claim 13, Austin discloses wherein the meta-data comprises business information. (Austin Col 6 Lines 3-10)

In regard to dependent claim 14, Austin does not specifically disclose wherein the business information comprises at least one of item provider, item owner, item sponsor, and cost. However Stefik discloses a cost (Stefik Col 24 Lines 42-55). It would have been obvious to one of ordinary skill in the art to apply Stefik to Austin providing

Austin the benefit of having a cost so the user can know a price before accessing information.

In regard to independent claim 16, Austin discloses a first data store which stores a plurality of instances of archived material, wherein at least one of the instances comprises a plurality of items comprising at least one requested item comprising text and at least one image and at least one accompanying, non-requested item (Austin Col 6 Lines 1-5 and Col 11 Lines 40-45 i.e. text and images; Austin Col 17 Lines 25-30 i.e. non-requested item; Austin Col 10 Lines 1-32); the first item comprising at least one accompanying, non-requested item. (Austin Col 17 Lines 25-30 i.e. non-requested items).

Austin does not specifically disclose a second data store which stores a plurality of rules for replacing at least a first one of the plurality of items with a second item...; and a software module which creates a second instance of archived material based on the first instance by replacing the first item with the second item. However Stefik mention replacing or substituting information (Stefik Col 20 Lines 58-67 and Col 21 Lines 1-3). It would have been obvious to one of ordinary skill in the art to apply Stefik to Austin providing Austin the benefit of substituting or replacing information, which would be easier for the user.

Austin further fails to disclose use of a rule comprising selection based upon a geographical location associated with a user. However, Martin discloses use of a rule comprising selection based upon a geographical location associated with a user (column 5, lines 12-44: Here, a rule specifies what data is available to a user based

Art Unit: 2178

upon the geographic location of the user). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Austin and Stefik with Martin, since it would have allowed a user to restrict content to legal and appropriate content (Martin: column 5, lines 37-44).

In regard to dependent claim 17, Austin discloses wherein the first item comprises a first advertisement which is a substitutable advertisement, and wherein the second item comprises a second advertisement which is a current advertisement.

(Austin Col 10 Lines 33-45)

In regard to dependent claim 18, Austin does not specifically disclose wherein the first advertisement is determined to be substitutable by comparing a date on which a request is received with an expiration date associated with the first advertisement, wherein said date on which said document request is received is later than said expiration date. However Stefik discloses of an expiration date (Stefik Col 22 Lines 1-9). It would have been obvious to one of ordinary skill in the art to apply Stefik to Austin providing Austin the benefit of having an expiration date so the user can know which advertisements are current.

In regard to dependent claim 19, Austin does not specifically disclose wherein the second advertisement is determined to be current by comparing a date on which a request is received with an expiration date associated with the second advertisement, wherein said system date predates said expiration date. However Stefik discloses of an expiration date (Stefik Col 22 Lines 1-9). It would have been obvious to one of ordinary

skill in the art to apply Stefik to Austin providing Austin the benefit of having an expiration date so the user can know which advertisements are current.

In regard to dependent claim 20, Austin discloses wherein the data store of instances of archived material is resident on a first computing device and wherein the system further comprises a module which transmits the second instance to a second computing device communicatively coupled to the first computing device via a communications network. (Austin Col 6 Lines 20-39)

In regard to independent claim 24, Austin does not specifically disclose reading a node representative of a document; determining, based on the first node, that the document comprises a plurality of items, each of the items being represented by one of a plurality of second nodes; and for each second node: determining the geometric boundaries of the item represented by the node; and placing a piece of content associated with the item within the geometric boundaries of the item, wherein a first one of the items has a temporal constraint associated therewith, and wherein the act of placing a piece of content associated with the first item comprises identifying a piece of content that meets the temporal constraint. However Stefik mentions nodes and information associated with the nodes (Stefik Col 9 Lines 19-32). It would have been obvious to one of ordinary skill in the art to apply Stefik to Austin providing Austin the benefit of having nodes and the information associated with the nodes, which would provide better organization for the user.

Austin further fails to disclose use of a rule comprising selection based upon a geographical location associated with a user. However, Martin discloses use of a rule

Art Unit: 2178

comprising selection based upon a geographical location associated with a user (column 5, lines 12-44: Here, a rule specifies what data is available to a user based upon the geographic location of the user). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Austin and Stefik with Martin, since it would have allowed a user to restrict content to legal and appropriate content (Martin: column 5, lines 37-44).

In regard to dependent claim 25, Austin discloses wherein said piece of content that meets the temporal constraint comprises a ... advertisement, wherein the advertisement's ... is dependent upon the time that the advertisement is either printed or included in an electronically-provided document. (Austin Col 10 Lines 33-45)

Austin does not specifically disclose revenue generating. However Stefik mentions generating a revenue (Stefik Col 48 Lines 53-65). It would have been obvious to one of ordinary skill in the art to apply Stefik to Austin providing Austin the benefit of generating revenue to make a profit.

5. Claim 15, 21-23 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Austin, Stefik, and Martin and further in view of Fields et al. (herein after Fields) U.S. Patent No. 6,704,797 B1 filed 6/10/1999.

In regard to dependent claim 15, Austin does not specifically disclose wherein determining that at least one of the plurality of items is substitutable is based on the at least one item being outdated. However Fields discloses items that are outdated (Fields Figures 4 and 5). It would have been obvious to one of ordinary skill in the art to apply

Fields to Austin providing Austin the benefit of showing items that are outdated so the user can keep up with current items.

In regard to dependent claim 21, Austin discloses text, an image, and an advertisement (Austin Col 6 Lines 1-5) the item comprising at least one non-requested item accompanying a requested item. (Austin Col 17 Lines 25-30 i.e. non-requested items).

Austin does not specifically disclose a second data field comprising geometric data of the item, wherein the geometric data describes one of a physical location of the item within a page and the size of an item. However Stefik mentions a location of an item (Stefik Col 34 Lines 45-55 and Stefik Col 34 Lines 45-55). It would have been obvious to one of ordinary skill in the art to apply Stefik to Austin providing Austin the benefit of identifying the location on the page so the user can find the information.

Austin does not specifically disclose a third data field comprising relevancy data, wherein the relevancy date comprises a date beyond which an item is outdated. However Fields discloses items that are outdated (Fields Figures 4 and 5). It would have been obvious to one of ordinary skill in the art to apply Fields to Austin providing Austin the benefit of showing items that are outdated so the user can keep up with current items.

Austin further fails to disclose use of a rule comprising selection based upon a geographical location associated with a user. However, Martin discloses use of a rule comprising selection based upon a geographical location associated with a user (column 5, lines 12-44: Here, a rule specifies what data is available to a user based

Art Unit: 2178

upon the geographic location of the user). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Austin and Stefik with Martin, since it would have allowed a user to restrict content to legal and appropriate content (Martin: column 5, lines 37-44).

In regard to dependent claim 22, Austin discloses a fourth data field comprising a link, wherein the link comprises a reference to information related to the item. (Austin Col 6 Lines 3-10)

In regard to dependent claim 23, Austin does not specifically disclose a fifth data field comprising business information, wherein the business information comprises at least one of a provider of the item, an owner of the item, a sponsor of the item, and a cost associated with the item. However Stefik discloses a cost (Stefik Col 24 Lines 42-55). It would have been obvious to one of ordinary skill in the art to apply Stefik to Austin providing Austin the benefit of having a cost so the user can know a price before accessing information.

Response to Arguments

6. Applicant's arguments filed 9 March 2006 have been fully considered but they are not persuasive.

The applicant's main argument relies upon the belief that the references are improperly combined, based upon the assumption that Martin is nonanalogous art (pages3-4). However, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular

Art Unit: 2178

problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the particular problem to be solved is replacing materials based upon the geographic location of an individual. Martin proposes a solution to replacing materials based upon the geographic location of an individual (column 5, lines 37-44). Martin determines the geographic location of a user through a navigation receiver (Figure 1, item 19). This location is then compared with valid latitudes and longitudes to determine whether access to data (gaming mode) is appropriate (legal) at this location (Figure 1, item 21). If it is determined that the data (gaming mode) is inappropriate (not legal) at this location, the data is replaced with a suitable data substitute (amusement mode) (Figure 1).

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 2178

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kyle R. Stork whose telephone number is (571) 272-4130. The examiner can normally be reached on Monday-Friday (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kyle R Stork
Patent Examiner
Art Unit 2178

kr


CESAR PAULA
PRIMARY EXAMINER